UT LAW CLE Continuing Legal Education

eConference
2023 Advanced Patent Law (USPTO) eConference

Session 1 1.00 hr	**Section 101** This panel provides a review on the USPTO plan to update its Patent Examination Guidelines on Patent Subject Matter Eligibility (PSME) based on public comments. Includes a survey of recent Federal Circuit PSME cases with practice tips as well as highlights of a bill to revise PMSE law. **Stephen G. Kunin,** Maier & Maier PLLC - Alexandria, VA **Matthew Sked,** U.S. Patent and Trademark Office - Philadelphia, PA
Session 2 1.00 hr	**SEPs and License Agreements** As the mobile revolution evolves into next-generation services with self-driving cars and the Internet of Things, there continue to be new commercial practices, legal disputes, and policy debates over the licensing of patents on standardized telecommunications technologies like 5G. This panel discusses the current commercial and legal landscape of the licensing of standard essential patents (SEPs), and what to expect in the future. **Adam Mossoff,** Antonin Scalia Law School, George Mason University - Arlington, VA **Mike Diehl,** US Patent and Trademark office - Alexandria, VA **Isabella Fu,** Microsoft Corporation - Redmond, WA **Fabian Gonell,** Qualcomm - San Diego, CA
Session 3 1.00 hr	**Written Description and Enablement: Current Cases and Pending Decisions** **Carla Ji-Eun Kim,** Sterne Kessler Goldstein & Fox - Washington, DC **Nick Panno,** DLA Piper LLP US - Reston, VA
Session 4 0.75 hr	**Drafting Claims That Will Be Infringed** When you draft claims, what are you thinking about? Our clients want us to focus on covering their invention, but we know that a patent creates a negative right. It doesn't give your client the right to practice its invention, only to exclude others. In one school of thought, clients want patents that protect their businesses, this means using patents to keep competitors away from our clients' patent properties. This discusses ways of drafting claims that maximize the chances of covering competitors; that are difficult to design around. **Dale S. Lazar,** Antonin Scalia Law School George Mason University - Arlington, VA
Session 5 0.25 hr	**Keynote: View from the USPTO** **Vaishali Udupa,** Commissioner for Patents, U.S. Patent and Trademark Office - Alexandria, VA **Whitney Remily,** Birch Stewart Kolasch & Birch, LLP - Falls Church, VA
Session 6 0.50 hr	**PTAB Update** Hear an update from the Chief Judge on recent trends and developments in PTAB appeal and trial proceedings. **Hon. Scott R. Boalick,** Chief Judge, Patent Trial and Appeal Board, U.S. Patent and Trademark Office - Alexandria, VA

Session 7 0.75 hr	**Practice Before the PTAB, Part I: Changes to the Director Review Procedures and Discretionary Denial Practice** **Teresa Stanek Rea,** Crowell & Moring, LLP - Washington, DC **Hon. Michael Tierney,** U.S. Patent and Trademark Office - Alexandria, VA **Hon. Amanda Wieker,** U.S. Patent and Trademark Office, Patent Trial and Appeal Board - Richmond, VA
Session 8 0.75 hr	**Practice Before the PTAB, Part II: Joinder, Estoppel, Motions to Amend, and More** **W. Todd Baker,** Kirkland & Ellis LLP - Washington, DC **Hon. Melissa Haapala,** U.S. Patent and Trademark Office, Patent Trial and Appeal Board - Boulder, CO **Hon. Miriam L. Quinn,** U.S. Patent and Trademark Office, Patent Trial and Appeal Board - Dallas, TX
Session 9 0.75 hr	**Patenting Issues Applicable to AI Inventions** This panel discusses issues related to inventorship, subject matter eligibility, and scope of patentability of AI inventions. **Jeanette Berberich,** Salesforce - New York, NY **Susan Krumplitsch,** DLA Piper LLP US - East Palo Alto, CA **Nalini Mummalaneni,** U.S. Patent and Trademark Office - Alexandria, VA
Session 10 1.00 hr | 1.00 Ethics	**Ethics Issues Facing USPTO Practitioners** An overview of issues pertinent to practice before the USPTO in patents and trademarks, including the certifications made upon submission of papers to the Office, along with best practices for verifying information from clients. **Emil Ali,** McCabe & Ali, LLP - Los Angeles, CA **Tim Rooney,** U.S. Patent and Trademark Office, Office of Enrollment and Discipline - Alexandria, VA
Session 11 1.00 hr	**Implications of Unitary Patents and the Unified Patent Court** **Robert Greene Sterne,** Sterne, Kessler, Goldstein & Fox P.L.L.C. - Washington, DC **Florian Meyer,** Meissner Bolte mbB - Munich, Germany **Mario Pozzi,** SIB LEX s.t.a. - Milan, Italy **Gwilym Roberts,** Kiburn & Strode - London, United Kingdom
Session 12 0.75 hr	**Challenges to Obviousness Type Double Patenting, Including patents with PTE or PTA** Obviousness-type double patenting is a judicial creation designed to preclude improper time extension of patent rights by proscribing the issuance of claims in a second patent that are directed to subject matter that is “different but not patentably distinct from the subject matter claimed in the prior patent.” But there must be some clear evidence to establish why the invention's variation in the second patent or application would have been obvious. This presentation discusses responding to OTDP rejections, as well as the implications when the patent in question has PTE or PTA. **Kakoli Caprihan,** U.S. Patent and Trademark Office, Office of the General Counsel - Alexandria, VA **Tom Irving,** Finnegan, Henderson, Farabow, Garrett & Dunner, LLP - Washington, DC
Session 13 0.75 hr	**Very Hot Topics in Design Patents** There are two major questions of first impression pending before the Federal Circuit. Design patent scope has been turned on its head by *In re: Surgisil*, greatly affecting not only

	patentability but infringement analysis (*Columbia v. Serius*). Regarding obviousness, the Federal Circuit in *LKQ v. GM* is grappling with the unresolved issue of whether KSR applies to design patents, potentially overturning years of case law. **Perry Saidman,** Saidman DesignLaw Group, LLC - Silver Spring, MD
Session 14 1.00 hr	**Federal Circuit and SCOTUS Year in Review** A review of the most important cases from the Federal Circuit and the Supreme Court in the past year that every practitioner should know. **Joe Matal,** Haynes Boone, LLP - Washington, DC
Session 15 1.00 hr | 1.00 Ethics	**Ethics in IP Practice** This session covers conflicts of interest in patent litigation, opinions, and prosecution. **David Hricik,** Mercer University School of Law - Macon, GA